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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,217	07/01/2003	Mitchell A. Gilbert	MGIL.02P	1216

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SUITE 211-B
LAS VEGAS, NV 89119-5154

EXAMINER

HAYES, BRET C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,217

Applicant(s)

GILBERT, MITCHELL A.

Examiner

Bret C Hayes

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/25/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 4 – 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 4 recites the limitation "the first section" in line 3. There is insufficient antecedent basis for this limitation in the claim.
4. Any unspecified claim is rejected as being dependent upon a rejected base claim.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 – 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,588,138 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 recites, "a fishing lure...comprising: a bi-chamber substantially cylindrical body having

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a front section and an aft section, with a first chamber located within the front section and a second chamber having an access opening formed in the aft section, the front section and aft section attached to one another by an unrestrained hinge connection, with the access opening located adjacent thereto, the aft section provided with...a plurality of openings enabling fluid communication," which is substantially recited in the claims. The only difference being a plug 90 (or end cap 36), which is included to block off an interior buoyancy chamber, as set forth at col. 3, line 25 (3:25). One well-known means for accomplishing similar relates to the 'message in a bottle' idea: an interior buoyancy chamber (a bottle) and a plug (a cork).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,079,145 to Barringer.
8. Barringer discloses the claimed invention including, (claim 1) a fishing lure 10 comprising: a longitudinally extending outer body having a hinged opening, set forth at col. 3, line 22 (3:22) and including, *inter alia*, 20, formed therein, the outer body defining an interior chamber 12 and 70 that extends throughout a substantial portion of the outer body; a plug, the wall running substantially parallel to ball bearings 72, as seen in Figs. 2 – 6, located within the interior chamber and attached to an inner wall thereof about an entire periphery of the plug in a

manner forming a sealed relationship between the plug and the inner wall, thereby defining a first interior chamber **70** and a second interior chamber **12**, the second interior chamber **12** in fluid communication with the hinged opening **20** of the outer body.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barringer.

11. Re – claim 2, Barringer discloses the claimed invention including: wherein the outer body has an aperture **42** formed therein, the aperture in fluid communication with the second interior chamber **12**. However, Barringer does not disclose a plurality of apertures. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of apertures, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

12. Re – claim 3, Barringer discloses wherein the hinged opening further comprising a cover **20** attached to the outer body by “a hinge (not shown)”, at 3:15, the cover **20** overlying an opening formed in the outer body and in communication with the second interior chamber **12**.

13. Re – claim 4, Barringer discloses wherein the outer body is divided into a front section, that surrounding **70**, and an aft section, that surrounding **12**, with the first interior chamber **70** within the first section and the second interior chamber within the aft section.

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14. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barringer in view of either US Patent No. 2,937,467 to Capps (as cited by Applicant).

15. Re – claim 5, Barringer discloses the claimed invention except for the hinge attached to and extending between both the front section and the aft section. Capps teaches a hinge **25** attached to and extending between a front section **2** and an aft section **16** in the same field of endeavor for the purpose of providing a hinge connection between two sections. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barringer to include the hinge being attached to and extending between both the front section and the aft section as taught by Capps in order to provide a hinged connection between the sections.

16. Re – claim 6, Barringer in view of Capps discloses the claimed invention except for the plug being located adjacent the hinge. Capps teaches a plug **10** being located adjacent the hinge **25** in the same field of endeavor for the purpose of securing the hinge **25** to the section **2**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Barringer to include the plug being located adjacent the hinge in order to secure the hinge to the section.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

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If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (703) 306 - 4198. The fax number is (703) 872 - 9306.

bh

7/19/04



MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER